

Please Direct All Correspondence to Customer No. 20995

Applicant : Jorneus et al.

App. No : 10/574,313

Filed : December 13 2006

IMPLANT ARRANGEMENT WITH
For : AN INTERNAL SOCKET FOR A
TURNING TOOL

Examiner : Yogesh Patel

Art Unit : 3732

APPELLANT'S REPLY BRIEF**Mail Stop Appeal Brief-Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicant (Appellant herein) replies to the Examiner's Answer to Appellant's Appeal Brief. The Examiner's Answer was dated April 27, 2009. Pursuant to 37 C.F.R. § 1.193(b)(1), the two-month deadline for filing this reply brief is June 27, 2009. Appellant submits that the Examiner's Answer does not include any new grounds of rejection and this Reply should be considered with Appellant's Appeal Brief.

Status of Claims begins on page 2 of this paper.

Grounds of Rejection to be Reviewed on Appeal begin on page 3 of this paper.

Arguments begin on page 4 of this paper.

Docket No.: NOBELB.233NP
Appl. No.: 10/574,313
Filing Date: December 13, 2006

Customer No.: 20995

I. STATUS OF CLAIMS

Claims 1, 3-7, 10 and 12-20 are currently pending in the application and are the subject of this appeal. Claims 2, 8-9, and 11 were previously cancelled. All of the pending claims were rejected in the final Office Action having a notification date of September 26, 2008. The pending claims are listed in the Claims Appendix.

Claims 1, 3-7, 10 and 12-16 stand rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1, 3-7, 10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2002/0177105 issued to Engman in view of U.S. Patent No. 4,681,541 issued to Snaper.

Applicants note that Claims 18-20 have been objected to. Although amendments are not allowed at this time, Applicants note that the error is inadvertent and obvious, where Claims 18 and 20 should depend from Claim 17, and Claim 19 should depend from Claim 18.

Docket No.: NOBELB.233NP
Appl. No.: 10/574,313
Filing Date: December 13, 2006

Customer No.: 20995

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

As the grounds of rejection for review:

1. Whether Claims 1, 3-7, 10 and 12-16, under 35 U.S.C. § 112, ¶ 2, are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention?
2. Whether Claims 1, 3-7, 10 and 12-20 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application No. 2002/0177105 issued to Engman in view of U.S. Patent No. 4,681,541 issued to Snaper?

III. ARGUMENT

A. The Rejection of Claims 1, 3-7, 10 and 12-16 under 35 U.S.C. § 112, ¶ 2 for Indefiniteness

In the Examiner's Answer, Examiner states that "Applicant is missing the first lateral surfaces of the drive tool." As discussed in Appellant's Appeal Brief, the "second lateral surfaces" of the drive part interact with the "first lateral surfaces" of the socket of the dental implant. Examiner appears to base his rejection on the non-existence of a "first lateral surfaces" of the drive tool, which he requires in addition to the "second lateral surface" of the drive tool. That is, the Examiner believes that the "second lateral surfaces" is indefinite because no "first lateral surface" is claimed for the drive tool. The Examiner's Answer implies that the word "second" makes it unclear how many lateral surfaces are being claimed on the drive part. However, Applicant submits that it is clear that Claim 1 is reciting a first lateral surface on the implant and a second lateral surface on the drive tool. As stated in MPEP § 2173.02, "[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. (Emphasis added). There is no confusion in the claim language with respect to the lateral surfaces – the implant and the drive tool each have lateral surfaces that interact with each other. Accordingly, Appellant asserts that Claims 1, 3-7, 10 and 12-16 are in condition for allowance.

B. The Obviousness Rejection of Claims 1, 3-7, 10 and 12-20 over Engman in view of Snaper

In the Examiner's Answer, Examiner agrees that Engman does not disclose the element of a friction enhancing coating. As discussed in Appellant's Appeal Brief, Engman nor Snaper discloses anything regarding titanium nitride for the purpose of creating more friction or otherwise enhancing the torque between a turning instrument and an implant. The use of titanium nitride in Snaper is to preserve sharp cutting edges, not to enhance friction. The applications of enhancing friction and preserving sharp cutting edges are entirely different and have completely different requirements. Therefore, a person of ordinary skill in the art would not have been motivated to combine these two references as suggested by the Examiner. That is, it

Docket No.: NOBELB.233NP
Appl. No.: 10/574,313
Filing Date: December 13, 2006

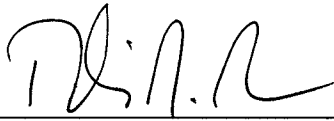
Customer No.: 20995

would not be reasonable to expect one of skill to apply a coating used to preserve sharp cutting edges on a dental burr configured to engage bone to surfaces that engage two parts together in order to enhance friction. Accordingly, Appellant asserts that Claims 1, 3-7, 10 and 12-20 are in condition for allowance.

C. Conclusion

For at least the reasons explained above, Applicants respectfully submit that the rejections of Claims 1, 3-7, 10 and 12-20 are improper and should be reversed. Please charge any additional fees that may be required now or in the future to Deposit Account No. 11-1410.

Dated: June 29, 2009

By: 

Rabinder N. Narula
Registration No. 53,371
Attorney of Record
Customer No. 20995
(949) 760-0404

7258523
062909